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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,221

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Shigehiro Yamaguchi

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EXAMINER

KOSACK, JOSEPH R

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

05/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,221	Applicant(s) YAMAGUCHI ET AL.	
	Examiner Joseph R. Kosack	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/2/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-12 are pending in the instant application.

Amendments

The amendment filed on February 2, 2009 has been acknowledged and has been entered into the instant application file.

Information Disclosure Statement

The Information Disclosure Statement filed on February 2, 2009 has been considered by the Examiner.

Previous Claim Rejections - 35 USC § 112

Claims 4-7 were previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant has traversed the rejection on the grounds that the term *having a number average polystyrene-equivalent molecular weight of 10^3 to 10^8* is an accurate quantitative measure of the molecular weight distribution for synthetic polymers that is determined via size exclusion chromatography. The Applicant has submitted the teaching of Dawkins as cited in the Information Disclosure Statement which teaches how to calculate the number average molecular weights in Equation 30 on page 251.

The Examiner still believes that the term is unclear. The term is not directed to a number average molecular weight but to a number average polystyrene-equivalent molecular weight. The Applicant has not explained what a polystyrene-equivalent is. The person of ordinary skill would not know what a polystyrene-equivalent molecular

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weight it from reading the specification or the teaching of Dawkins. Some plausible definitions would include: the number of polystyrene monomers included in the finished polymer, the number of polystyrene monomer molecular weights in the finished polymer, the number of molecular weights of a polystyrene equivalent such as poly-4-methylstyrene in the finished polymer, etc... The term needs to be defined exactly in order for the person of skill in the art to know the metes and bounds of the invention. Therefore, the Examiner is left no choice but to maintain the rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Base claim 4 is drawn to “a polymer comprising a compound of formula (4) as a repeating unit and *having a number average polystyrene-equivalent molecular weight of 10^3 to 10^8 .*” The italicized term is indefinite for the following reasons. Firstly, it is unknown what units the molecular weight is to be measured in as none are given in the claim. Is it grams/mole, kilograms/mole, milligrams/mole, ect...? Second, what about the molecular weight makes it “number average polystyrene-equivalent?” Does this mean that only part of the entire polymer molecular weight is used to meet the patent claim or the whole polymer molecular weight? If it is only part of the molecular weight, which part is it?

Therefore, as base claim 4 contains an indefinite limitation and claims 5-7 depend on that limitation, claims 4-7 do not meet the clarity requirement of 35 U.S.C. 112, second paragraph.

Conclusion

Claims 4-7 are rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Kosack whose telephone number is (571)272-5575. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph R Kosack/
Examiner, Art Unit 1626

/REI-TSANG SHIAO /
Primary Examiner, Art Unit 1626